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MAILED
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OFFICE OF PETITIONS

In re Patent of Darzynkiewicz et al.	:	
Patent No. 5,912,126	:	
Issue Date: June 15, 1999	:	Decision on Petition
Application No. 08/727,509	:	
Filing Date: October 22, 2006	:	
Attorney Docket No. 1080/0011US1	:	

This is a decision on the petition under 37 CFR 1.378(b), filed October 14, 2010, to reinstate the above-identified patent.

The petition is **DISMISSED**.

Facts

The patent issued June 15, 1999.

Petitioner hired Computer Patent Annuities Global, Ltd. ("CPA") to track maintenance fee due dates for the instant patent.

Catharine Crea, the Associate Dean for Research Administration for Petitioner, states, "CPA and [Petitioner] have worked together to manage the docketing of a total of 5 patents." Crea Declaration, ¶ 20.

Crea describes a "business routine between [Petitioner] and CPA for docketing and ensuring payment of maintenance fees is described below." *Id.* at ¶10. Crea states, "Such system has not substantially changed since [Petitioner] and CPA began working together, because it had proven to be greatly successful and reliable." *Ibid.*

The business routine between Petitioner and CPA consisted of the followings steps:

1. CPA would send a letter notifying Petitioner when a maintenance fee became payable,
2. The letter would be forwarded to the proper person to handle the matter,
3. Petitioner would internally approve payment of the fee,

4. Petitioner would notify CPA that it is authorized to pay the fee,
5. CPA would pay the fee, and
6. CPA would send [Petitioner] an invoice for the fee.

The 3.5 year maintenance fee for the instant patent was due from June 15, 2002, to Monday, December 16, 2002, or with a surcharge from December 17, 2002, to Monday, June 16, 2003.

On July 1, 2002, CPA sent a renewal notice to Petitioner. The notice asked if Petitioner wished for CPA to pay the 3.5 year maintenance fee for the instant patent.

Stella Manne, the Director of Petitioner's Technology Department, sent CPA instructions to pay the fee on July 10, 2002.

CPA timely paid the 3.5 year maintenance fee on August 29, 2002.

Petitioner laid off Manne on October 27, 2005. Manne's responsibilities, including the management of intellectual property matters, were assigned to Crea, Manne's supervisor. From 2006 to 2007, Crea managed 26 patents and patent applications on behalf of Petitioner.

Alison Goveia handled the distribution of all mail and packages received in the Office of Research Administration at Petitioner during all the time periods at issue. After Manne was laid off, Goveia was instructed to forward all mail addressed to Manne to Susan Dudick, Crea's administrative assistant.

Goveia has acknowledged she was aware of the need to forward Manne's mail to Crea. Goveia states, "I knew that all mail addressed to Dr. Manne was to be redirected to Associate Dean Catherine Crea." Govia Declaration, ¶ 5.

Crea and Dudick reviewed mail Crea's mail, and mail forwarded to Crea, daily and "Crea would decide the appropriate response for each piece of mail." *Id.* at ¶ 28.

The 7.5 year maintenance fee for the instant patent was due from June 15, 2006 to December 15, 2006, or with a surcharge from December 16, 2006, to June 15, 2007.

CPA sent a reminder to Petitioner on June 30, 2006. The reminder indicated the 7.5 year maintenance fee was due for the instant patent and asked if Petitioner wished for CPA to pay the fee.

CPA did not receive a response to the June 30, 2006 reminder.

CPA sent a second reminder to Petitioner on September 1, 2006.

CPA did not receive a response to the September 1, 2006 reminder.

CPA sent a third reminder to Petitioner on December 29, 2006.

CPA did not receive a response to the December 29, 2006 reminder.

CPA sent a fourth reminder to Petitioner on May 1, 2007.

CPA did not receive a response to the May 1, 2007 reminder.

Neither CPA nor Petitioner paid the 7.5 year maintenance fee and the patent expired June 16, 2007.

Crea states she never received any notice from CPA, or any other party, that the 7.5 year maintenance fee was due for the instant patent.

On December 17, 2009, Crea learned, via an e-mail from Waldemar Comas, general counsel for Petitioner, that the patent had expired.

For unclear reasons, Crea "believed that locating the physical, law firm patent prosecution file would be helpful in resolving both the immediate problem ... as well as preventing future non-payment maintenance fees for the instant patent." Crea Declaration at ¶ 37.

Prosecution of the application was handled by the law firm of Skadden, Arps, Slate, Meagher & Flom, L.L.P. ("Skadden"). Crea contacted Skadden on December 30, 2009, and was informed the file had been transferred to Stefan Kirchanski of Graham & James, L.L.P. ("Graham") during 1998.

Crea sent an e-mail to Comas on December 31, 2009, asking him for help in finding Kirchanski.

On February 12, 2010, Crea sent an e-mail to Comas reminding him of the request she had made in the e-mail sent December 31, 2009.

On March 18, 2010, Crea sent an e-mail to Comas reminding him of the prior two e-mails and stating she was still waiting to receive the requested information.

The record fails to indicate Comas ever made any attempt to locate Kirchanski.

On or about May 5, 2010, Crea contacted Skadden in an attempt to obtain additional information concerning Kirchanski. However, she was unable to obtain additional information.

On or about May 6, 2010, Crea contacted the licensee in an attempt to locate information pertaining to Kirchanski. The licensee provided Crea with contact information for Kirchanski.

On an unidentified date, Crea learned the law firm of Graham & James had dissolved during July 2000.

On or about May 7, 2010, Crea contacted Kirchanski to locate the file. Crea does not discuss the substance of the conversation with Kirchanski.

Crea states, on May 12, 2010, after her unsuccessful attempts to locate the physical file and obtain additional information, she contacted the law firm of Nada Jain, P.C. to investigate the matter and to take steps to reinstate the patent.

The instant petition was filed October 14, 2010.

Law

A grantable petition under 37 CFR 1.378(b) must be accompanied by a showing to the satisfaction of the Director that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable.

In order for a party to show unavoidable delay, the party must show "reasonable care was taken to ensure that the maintenance fee would be promptly paid."¹ The level of "reasonable care" required to be shown is the same as the level of "care or diligence ... generally used and observed by prudent and careful men in relation to their most important business."² When determining if a period of delay has been shown to have been unavoidable, the Office will take "all the facts and circumstances into account" and will decide each petition "on a case-by-case basis."³

35 U.S.C. 41(c)(1) states, with emphasis added, "The Director may accept the payment of any maintenance fee . . . after the six month grace period if the delay is *shown to the satisfaction of the Director* to have been unavoidable." Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

The Office and Congress have recognized the unavoidable standard can be very difficult to meet. During 1992, Congress considered the difficulty involved in reinstating a patent under the unavoidable. Congressional representatives described the unavoidable standard as inflexible, extremely hard to meet, too stringent and harsh.⁴ Congress did NOT take steps to make the

¹ 37 CFR 1.378(b).

² *In re Mattulath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). *See also Ray v. Lehman*, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

³ *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982).

⁴ "[The unavoidable] standard has been found to be extremely hard to meet. Some patent owners have lost their patent rights due to this inflexible standard." 138 CONG. REC. S16613, 16614 (September 30, 1992) (Rep. DeConcini) (emphasis added). "The unavoidable standard has proved to be too stringent in many cases." 138 CONG. REC. H1115 (October 3, 1992) (Rep. Hughes) (emphasis added). "The unavoidable standard is 'too stringent'. Some patent owners have lost their patent rights due to circumstances that do not warrant this harsh result, but that could not be considered 'unavoidable' under current law." 138 CONG. REC. E1688 (June 4, 1992) (extension of remarks of Rep. McCollum) (emphasis added).

unavoidable standard more flexible, easier too meet, less stringent, or less harsh. Instead, Congress determined that it would allow patent owners the ability to reinstate a patent under an "unintentional" standard as long as the petition was filed within 24 months of the expiration of the patent. Congress chose to continue requiring proof of unavoidable delay for petitions filed after the 24 month time period.

Discussion

The Failure to Timely Pay the 7.5 Maintenance Fee

Crea describes a simple routine to be followed for the five patents docketed by CPA. In essence:

1. CPA would send Petitioner a reminder notice,
2. Petitioner would receive the notice,
3. The notice would be forwarded to Crea, and
4. Crea would send CPA instructions to pay the fee.

Petitioner states CPA sent four reminders *and* states Crea never received any of the reminders. Assuming Crea never received the reminders, the following would appear to be true for each reminder:

1. The United States Postal Service, or other mail carrier used by CPA, never delivered the reminder to Petitioner, or
2. The mail was received, but was not successfully forwarded to Crea.

Petitioner asserts the process in place to ensure mail would be properly forwarded to Crea was reliable. Crea's asserts the routine at issue has successfully and reliably been followed for maintenance fees due for all the other patents handled by CPA.

Petitioner's arguments might well be persuasive *if* only one reminder had not been received by Crea. However, in view of the *extremely minimal* probability of *all four* reminders being lost by the mail carrier, the record is insufficient to establish the Petitioner's process for handling mail was reliable.

Any request for reconsideration must demonstrate the system in place for handling mail from CPA was reliable despite the loss of all four reminders mailed by CPA informing Petitioner the 7.5 year maintenance fee was due.

Crea asserts the routine at issue has remained substantially unchanged since Petitioner first hired CPA and states the routine has been successfully and reliably followed for the other four patents. However, Crea does not identify the other patents. Crea also does not include a discussion of relevant facts concerning the other patents. Any request for reconsideration should identify the other four patents, *and for each patent*, supply a copy of all correspondence sent to Petitioner from CPA, a copy of all correspondence received from CPA, and a copy of all correspondence sent to CPA.

Delay in Filing a Petition to Reinstate the Patent

A grantable petition under 37 CFR 1.378(b) must demonstrate the entire delay in the submission of the maintenance fee was unavoidable. In other words, the instant petition cannot be granted absent evidence demonstrating the period of delay from December 17, 2009, the date Crea learned the patent had expired, until October 12, 2010, the date the instant petition was mailed to the Office, was unavoidable.

Petitioner has failed to prove the delay resulting from Crea's attempts to locate the physical file was unavoidable.

Crea states she believed the physical, prosecution file might be helpful in resolving the immediate problem. However, Crea fails to identify the basis for such a belief or demonstrate the belief was reasonable. Crea also states she believed possession of the file would help prevent the future non-payment of fees for the instant case. However, Crea fails to provide the basis for such a belief or demonstrate the belief was reasonable.

Petitioner has not demonstrated the over four months of delay spent attempting to locate Kirchanski was unavoidable delay.

From December 31, 2009, to May 5, 2010, the only attempt Crea made to locate Kirchanski was to send three e-mails requesting Comas' assistance in locating Kirchanski. The record fails to establish Comas ever took any steps to locate Kirchanski.

The record fails to prove a person using the level of care and diligence normally used by reasonable and prudent individuals when handling their most important business would not have taken more than four months to locate Kirchanski. For example, the record fails to prove a reasonable person would not have attempted to use the internet to locate Kirchanski, *and* fails to prove Crea or Comas would not have been able to locate Kirchanski in minimal time, perhaps in seconds, using Google or another internet search engine.

Petitioner has not demonstrated Petitioner's delay in contacting the law firm of Nada Jain was unavoidable delay.

Petitioner has failed to demonstrate a reasonable and prudent person, treating the patent the same as the person would treat the person's most important business, would have waited five months to contact the law firm. The instant petition could have been prepared and filed on an earlier date absent Petitioner's delay in contacting the law firm.

The record fails to prove the entire 6-month period of delay from the date Petitioner contacted current counsel until the date the petition was filed was unavoidable.

The petition discusses steps taken by current counsel, but does not identify the amount of time or dates associated with the tasks. For example, counsel does not discuss the time spent requesting information from Petitioner or the amount of time Petitioner spent responding to such a request. Any request for reconsideration should *fully* discuss the six-month period of delay.

Conclusion

In view of the prior discussion, the showing of record is not sufficient to establish the entire delay in the submission of the maintenance fee was unavoidable.

The petition is signed by Attorney Nada Jain. There is no indication in the record that Attorney Jain was ever given a power of attorney or authorization of agent for the instant case. If Attorney Jain wishes to receive future correspondence regarding this patent, the appropriate power of attorney or authorization of agent must be submitted. Although the decision is being mailed to Attorney Jain at the address set forth in the petition, all future correspondence will be directed to the address currently of record unless appropriate instructions are received to the contrary.

Petitioner's Current Options

Petitioner may file a request for reconsideration.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted. Any petition for reconsideration of this decision must be accompanied by a non-refundable petition fee of \$400 as set forth in 37 CFR 1.17. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.378(b)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

After a decision on the petition for reconsideration is issued, no further reconsideration or review of the matter will be undertaken by the Director. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

Petitioner may request a refund of the maintenance fee and surcharge,
which accompanied the petition.

Since the petition is dismissed, petitioner may request a refund of the maintenance fee and surcharge instead of filing a request for reconsideration. Petitioner is reminded that if a request for reconsideration is later filed along with the \$400 fee, the \$400 will not be refunded. A request for a refund should be sent to: Mail Stop 16, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany any request for refund.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.⁵
Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries regarding this communication should be directed to Petitions Attorney
Steven Brantley at (571) 272-3203.



Charles Steven Brantley
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Office of Petitions

⁵ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.